

REMARKS

Claims 1 – 16 are pending, and claims 1 – 16 stand rejected. The applicant respectively traverses the rejection and request allowance of claims 1 – 16.

Claims 1- 9 are rejected under 35 U.S.C 101 as being directed to non-statutory subject matter. The examiner stated that claims 1 – 9 lacked sufficient technology and that “the PTO requires references to a technology in a non-trivial way in the body of the claim.” The examiner states that the rejection relies on *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat App. & Inter. 2001)(Unpublished) and that the claim represents merely an abstract idea. The reliance on *Ex parte Bowman* is misplaced. In *Bowman*, the use of a computer was not mentioned in the claim or in the specification. In fact the court stated that there was “absolutely no indication on this record that the invention is connected to a computer in any manner.” 1671 Id. Further the court stated that “the physical aspect of claim 1, which are disclosed to be nothing more than a human manually drawing a chart and plotting points on this chart, do not automatically bring the claimed invention within the technological arts”. Id. Here, claim 1 specifies that the method is performed in a billing system for a communication network. A communication network is well known in the arts and typically comprises computers, software, switches, optical links, wire and wireless links, and handheld devices. A well known communication network is the telephone network. This limitation in claim 1 certainly references a technological art in a meaningful way. Furthermore, the specification makes it clear that the communication network operates using at least one computer. Therefore the Examination Guidelines for Computer-Related Inventions apply to this application.

When the method of claim 1 is implemented as a computer program, claim 1 has

the limitation that the method is preformed in a billing system for a communication network. When a computer program is claimed as part of an otherwise statutory manufacture or machine, the claim remains statutory irrespective of the fact that a computer program is included in the claim... Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence non-statutory. MPEP. Claim 1 is a method of billing in a billing system for a communication network. A communication network is certainly a statutory machine. Therefore, even if/when a computer program is used to generate the invoice, the claim remains statutory subject matter.

The examiner states that when the communication network is read as a machine, then the billing system would be for the machine. Billing systems are also well known in the arts. Many billing systems operate independent of, but in cooperation with, communication networks (see figure 1). Some billing systems are a part of the communication network. There is nothing incorrect with the interpretation that the billing system is for a machine (the machine being a communication network). Claim 1 is clear that "generating account information..." happens "in a billing system for a communication network". Claim 1 is a method of billing, used in a billing system for a communication network and is clearly statutory subject mater. Further, the technological arts are mentioned in a meaningful way in the body of claim 1. Therefore claim 1 is allowable as written.

Claims 2 – 8 are dependent on allowable claim 1 and are therefore allowable. Claim 9 also has limitations requiring a call processing system and an invoice system in a

billing system. Therefore the argument for claim 1 applies to claim 9 and claim 9 is allowable as written.

Claims 1- 16 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as their invention. The examiner states that "a billing system, a call processing system and a billing system are indefinite in that it can not be determined if the system(s) are a system of components or a method." The claims are not read in a vacuum, the claims are read in light of the teaching in the specification and the knowledge for one of ordinary skill in the prior art. "In rejecting a claim under the second paragraph of 35 USC 112, it is incumbent on the examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims." *Ex parte* Wu, 10 USPQ 2d 2031, 2033 (B.P.A.I. 1989). The examiner has not met his burden of establishing that one of ordinary skill in the pertinent art would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims, read in light of the specification.

The claim language makes it clear that the billing system and the call processing system are a system of components in both claim 1 and claim 9. Claim 1 is a method claim. A method claim is a claim for a combination of steps. Claim 1 lists a number of steps to perform (receiving information, processing information, etc.). Describing, in a method claim, where the method is performed, is perfectly acceptable claim construction. In claim 1, the steps of the method are performed "in a billing system for a

communication network". It's clear in the context of claim 1 that the "billing system" is a system of components and not a method. In contrast to claim 1, claim 9 is an apparatuses claim and lists a number of elements that comprise the billing system (a call processing system, an invoice system). It is apparent that the call processing system is a system of components in claim 9. Therefore claim 1 and claim 9 are not indefinite and it is respectively requested that the 112 rejection is withdrawn.

Claims 2 – 8 are dependent on allowable claim 1 and claims 10 – 16 are dependent on allowable claim 9 and are therefore allowable.

The examiner had requested information under 37 CFR 1.105. I believe that the applicable section is 37 CFR 1.105 (a)(1)(vi) which is reproduced below.

§ 1.105 Requirements for information. (a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(vi) *Improvements:* Where the claimed invention is an improvement, identification of what is being improved.

MPEP 704.14(a)

The requirement should state why the requirement has been made and how the information is necessary to the examination.

The examiner has not stated why the requirement has been made or how the information requested is necessary to the examination as specified by MPEP 704.14(a). Without knowing how the information is necessary for the examination, it is difficult to understand what information the examiner needs. However, the applicant will identify what the current invention improves as required by 37 CFR 1.105(a)(1)(vi). The invention of the current application is a system and method for improving a billing

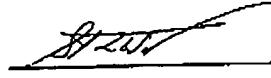
system for a communication network. The billing system is being improved when operated in accordance with the steps of the method of claim 1.

Conclusion

Based on the above remarks, the Applicants submit that claims 1 - 16 are allowable. There may be additional reasons in support of patentability, but such reasons are omitted in the interests of brevity. The Applicants respectfully request allowance of claims 1 - 16.

Respectfully submitted,

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